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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI OSHIMA

Appellant

Appeal 2008-5026
Application 08/988,181
Technology Center 3700

Decided: November 5, 2008

Before JAMESON LEE, SALLY GARDNER LANE, and
SALLY C. MEDLEY *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The appeal is from a Final Rejection of claims 12-43, 35 U.S.C. § 134, which are all of the pending claims. (App. Br. 4). We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

The application was filed December 10, 1997. The real party in interest is said to be Bridgestone Sports Co., Ltd. (App. Br. 2).

The Examiner relied on the U.S. Patent 1,676,975 (“Anderson”), which issued July 10, 1928, to reject claims 12-43 under 35 U.S.C. § 103(a). Appellant did not argue against the prior art status of this reference. Appellant discussed independent claims 12 and 31, but did not argue separately for the patentability of any of the dependent claims. (*See* App. Br. 13).

II. FINDINGS OF FACT

The record supports the following findings of fact as well as any other findings of fact set forth in this opinion, by at least a preponderance of the evidence.

1. Appellant’s claim 12 recites:

A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball,

said section including two or more subsections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.

(App. Br. 14).

2. Appellant’s claim 31 recites:

A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising:

a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and

a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

(App. Br. 17).

3. Appellant noted in the specification that

[i]t is a common practice in the golf art to provide golf balls with indications of hardness and golf clubs with indications of shaft hardness for helping the golf player choose a matching golf ball or club. Japanese U.M. Application Kokai No. 35315/1990 proposes a golf instrument in which a golf ball or club is provided at an appropriate position with a mark corresponding to head speed.

The performance indication on the prior art golf instruments indicates only one of various functions associated with the golf ball or club. With such a single criterion, the golfer encounters difficulty [*sic*] in choosing a golf ball or club best suited for his or her skill and ability. In other words, prior art golf instruments do not provide visible indications of all of their functions. In fact, many golfers use golf balls and clubs which do not fully match with their skill and ability.

(Spec. 1, l. 15, through 2, l. 9; *see* Amendment received Feb. 23, 1998).

4. Anderson teaches a golf ball box “with a flap which is adapted to hold the golf balls in position even though the box be tipped on edge” (Anderson ll. 1-6).

5. Anderson teaches that the “upper side of the flap can be used for advertising matter or an explanation of the novelty of the box as desired.” (Anderson ll. 53-55).

III. LEGAL PRINCIPLES

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (Fed. Cir. 2007).

Known items with new printed matter may not be patentable. “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). “[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1386.

IV. ANALYSIS

Appellant’s specification teaches us that

[i]t is a common practice in the golf art to provide golf balls with indications of hardness and golf clubs with indications of shaft hardness for helping the golf player choose a matching golf ball or club. Japanese U.M. Application Kokai No. 35315/1990 proposes a golf instrument in which a golf ball or club is provided at an appropriate position with a mark corresponding to head speed.

The performance indication on the prior art golf instruments indicates only one of various functions associated with the golf ball or club. With such a single criterion, the golfer encounters difficulty [*sic*] in choosing a golf ball or club best suited for his or her skill and ability. In other words, prior art golf instruments do not provide visible indications of all of their functions.

(FF¹ 3). Appellant explains further that

each golf ball cannot be characterized by a single function or mark. Instead, the performance and characteristics of a golf ball is defined by a number and combination of various factors. . . . The invention takes into account various combinations of factors, performances characteristics, etc. that are important to a golfer in selecting the proper ball that is best suited to his game/style of golf.

(App. Br. 6). Thus, Appellant's claimed package provides information about more than one factor or characteristic of the enclosed golf balls. To this end, Appellant's claim 12 recites

[a] package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising:
a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and
a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

(FF 1), and Appellant's claim 31 recites

[a] package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising:

¹ Finding of Fact.

a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and

a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

(FF 2). Generally, the packages of Appellant's claims 12 and 31 include 1) a box body; 2) a cover; and 3) an "indication section" on the package, which describes the golf balls within. (*See* FFs 1 and 2).

Anderson also teaches a container for golf balls. (FF 4). Like the packages claimed by Appellant, the box taught by Anderson includes 1) a box body (FF 4); 2) a flap or cover that holds the golf balls in position (FF 4); and 3) written matter that can provide advertising or an explanation of the box (FF 5). Anderson does not specifically teach an "indication section" on a golf ball box, as claimed by Appellant. We must decide if the packages claimed by Appellant, which would include information about more than one characteristic, would be a predictable variation of the box taught in Anderson.

The written matter on the golf ball box of Anderson differs from the "indication section" of Appellant's claimed package. If the written matter of Appellant's "indication section" is "functionally related" to the package substrate, it may contribute to the patentability of Appellant's claimed package. *See Gulack, supra*. Previously, a "functional relationship" was found when a specific series of numbers was written in a sequence to determine prime numbers on an endless band, because "the printed matter and circularity of the band were interrelated, so as to produce a new product useful for 'educational and recreational mathematical' purposes. . . .the

printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result.” *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (explaining the holding in *Gulack*). In contrast, no “functional relationship” was found between a kit for a biological assay and instructions for using it in *Ngai* because “addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. . . . the printed matter in no way depends on the kit, and the kit does not depend on the printed matter.” *Id.*

The “indication section” of Appellant’s claimed packages is not interrelated or otherwise dependant on the package. Appellant’s package could use other means of conveying the same information, for example, with a purely textual description. Similarly, the “indication section” could be printed on other substrates than the package and convey the same information, for instance it could appear in advertising for the golf balls. In fact, the “indication section” is only a different way of conveying information about golf balls, similar to the different instructions for using the kit in *Ngai*. Like those instructions, “[a]ll that the printed matter does is teach a new use for an existing product.” *Ngai, id.* We find no “new and unobvious functional relationship between the printed matter and the substrate,” *Gulack*, 703 F.2d at 1386, of Appellant’s claims.

Appellant argued that

there is no disclosure or suggestion in Anderson to modify its box to include an indication section with at least two sub-sections. . . . In addition, there is no disclosure of suggestion in Anderson that the box has features similar to the claimed indication section including two or more sub-sections for

indicating performance characteristics of the golf ball as set forth in independent claim 12 or the claimed indicating section comprising a first sub-section and a second sub-section for indicating performance characteristics of the golf ball as set forth in claim 31.

(App. Br. 10). Appellant asserted that “the Examiner merely contends that indicia on a box is not patentable because it is not functionally related to the substrate (box) . . .” (App. Br. 10), and that this is “entirely inappropriate because the issue of whether the respective claimed indicating sections with the performance characteristics should be given patentable weight has already been decided in this application by the Board of Patent Appeals and Interferences.” (App. Br. 11). Appellant refers to Appeal No. 2002-1912, in which a different rejection based on different prior art was reviewed. The panel in that appeal stated:

In the present case, a functional relationship clearly exists between the printed matter (the icons and sets of descriptive information relating to performance characteristics of the golf ball) and the substrate (the golf ball package). Thus, the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight in assessing the obviousness of the claimed invention.

(Appeal No. 2002-1912, at 7). The previous panel did not provide any more explanation how the facts of the case demonstrate a functional relationship. We disagree with their conclusion and determine that there is no functional relationship between the indication section and the package for the reasons given above.

Appellant argued that

a functional relationship clearly exists between the printed matter and the golf ball package since either by itself cannot

provide the patentable advantages of easily picking a golf ball that is best suited to the golfer. That is, a golf ball package without the claimed indication of performance characteristics would not allow a golfer to easily pick a golf ball best suited for him or her, and providing printed matter of performance characteristics would not be beneficial without a link, such as a golf ball package, to the golf ball.

(App. Br. 12). We disagree. That there is a “link” between the “indication section” and the package does not determine that there is a “functional relationship” between the two. Instead, the Federal Circuit taught in *Ngai* that the functional relationship exists when there is some interrelated aspect of the printed material and the substrate, with each being dependant on the other. *Ngai, supra*. The same information conveyed by Appellant’s “indication section” could be provided in a different way. For example, the package might be positioned on a shelf in a display case that is labeled with the multiple characteristics of the balls. This arrangement would have no “link” between the package and the indication section, but would still allow the consumer to choose the most suitable golf ball.

The content of the “indication section” does not in any way change the structure or performance characteristics of the golf ball package. The “indication section” is no more functionally related to the package than text which states that the package is made of recycled paper or which indicates the particular brand of the golf ball. Knowing the brand of the golf ball may help a potential purchaser easily pick out a golf ball that is best suited for his or her needs. Knowing that the package is made from recycled paper may also help certain purchasers make up their mind about whether to make a

purchase. But printing such information on a golf ball package does not change the structure or functional performance of the package.

Appellant's arguments do not convince us that there is a functional relationship between the printed matter of Appellant's claimed package and the substrate of the package.

Furthermore, given Appellant's own report of the prior art as using marks to indicate one characteristic of a golf ball (FF 3), using marks or other written material to indicate more than one characteristic of a golf ball is merely a predictable variation. *See KSR, supra*. Because the specific written material claimed is not functionally related to the package on which it is displayed, we do not see that the Examiner erred in rejecting Appellant's claims under 35 U.S.C. § 103(a) over Anderson.

V. ORDER

Upon consideration of the record and for the reasons given, the Examiner's rejection of claims 12-43 under 35 U.S.C. § 103(a) over Anderson is AFFIRMED.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal 2008-5026
Application 08/988,181

MAT

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